

ESTTA Tracking number: **ESTTA543646**

Filing date: **06/18/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	VIATEL HOLDING (BERMUDA) LIMITED
Granted to Date of previous extension	06/19/2013
Address	CEDAR HOUSE, 41 CEDAR AVENUE HAMILTON, HM12 BERMUDA
Attorney information	DEAN R KARAU FREDRIKSON & BYRON PA 200 SOUTH SIXTH STREET, SUITE 4000 MINNEAPOLIS, MN 55402-1425 UNITED STATES ip@fredlaw.com, dkarau@fredlaw.com, cmoyer@fredlaw.com Phone:6124927178

### Applicant Information

Application No	79115921	Publication date	02/19/2013
Opposition Filing Date	06/18/2013	Opposition Period Ends	06/19/2013
International Registration No.	1124021	International Registration Date	04/13/2012
Applicant	VIETTEL GROUP No. 1, Giang Van Minh street Kim Ma ward,; Ba Dinh district; Hanoi  VIET NAM		

### Goods/Services Affected by Opposition

Class 038. All goods and services in the class are opposed, namely: Telecommunication services, namely, long-distance domestic and international telecommunication services using IP protocol; providing user access and connections to the Internet and Internet application in the field of telecommunication; rental of domestic and international transmission channel apparatus; telephone services; and land mobile phone services
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### Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1785855	Application Date	11/02/1992
Registration Date	08/03/1993	Foreign Priority Date	NONE
Word Mark	VIATEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1991/02/26 First Use In Commerce: 1991/02/26 intercontinental telecommunications services		

Attachments	Notice of Opposition.pdf(20943 bytes ) VIATEL Exhibit A.pdf(79639 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Dean R. Karau/
Name	DEAN R KARAU
Date	06/18/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of: Trademark Serial No. 79115921

For the Mark: 

Filed: April 13, 2012

Published: February 19, 2013

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Viatel Holding (Bermuda) Limited,

Opposer,

Opposition No. \_\_\_\_\_

v.

Viettel Group,

Applicant.

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**NOTICE OF OPPOSITION**

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This opposition is made to the applications of Applicant, Viettel Group, for registration of the mark above (“VIETTEL Mark”), Application Serial No. 79115921, published on February 19, 2013. Opposer, Viatel Holding (Bermuda) Limited, obtained an extension of time to oppose the application to June 19, 2013.

Opposer believes it will be damaged by the registration of the mark shown in the applications, and hereby opposes the same. As grounds for its opposition, Opposer states and alleges as follows:

1. Opposer is a corporation organized under the laws of Bermuda, with its principal place of business located at Cedar House, 41 Cedar Avenue, Hamilton, HM12 Bermuda.

2. On information and belief, Applicant is a limited liability company organized under the laws of Vietnam, with a principal place of business located at No. 1, Giang Van Minh Street, Kim Ma ward, Ba Dinh district; Hanoi, Vietnam.

3. On or about April 13, 2012, Applicant filed a request for an extension of protection of International Registration No. 1124021 to the United States for the VIETTEL Mark, and was given U.S. Application Serial No. 79115921. The application was subsequently published for opposition on February 19, 2013, for the services recited as telecommunication services, namely, long-distance domestic and international telecommunication services using IP protocol; providing user access and connections to the Internet and Internet application in the field of telecommunication; rental of domestic and international transmission channel apparatus; telephone services; and land mobile phone services, in International Class 38.

4. Opposer owns and uses the trademark VIATEL in the United States in connection with intercontinental telecommunications services in International Class 38, and owns U.S. Registration No. 1785855 for the same, issued on August 3, 1993, based on an application filed on November 2, 1992, claiming a date of first use and first use in commerce of February 26, 1991. A copy of the certificate of registration and the TSDR information for the registration is attached as Exhibit A herewith. The registration is valid and subsisting.

5. Opposer's VIATEL mark has been used continuously in advertising and promotional materials, and in other ways customary in the trade, to promote its services throughout the United States, and Opposer has developed good will through ownership and use of its mark. By reason of such advertising, promotion and widespread use, the consuming public recognizes Opposer's VIATEL mark and associates the mark with Opposer and its services.

6. Opposer's VIATEL mark is inherently distinctive and is a strong mark, and should be accorded the broad protection given to strong marks.

7. Use by Applicant of the trademark VIETTEL Mark for which registration is sought in the application opposed herein is likely to cause confusion, mistake or deception as to the source of origin, sponsorship, or approval of Applicant's services in that purchasers or others are likely to believe that Applicant's services are Opposer's services or are in some way legitimately connected with, licensed by, or approved by Opposer. Use by Applicant of the trademark VIETTEL Mark for which registration is sought in the application opposed herein has lessened, and will continue to lessen, the capacity of Opposer's VIATEL mark to identify and distinguish services provided by Opposer.

8. Use by Applicant of the mark VIETTEL Mark, for which registration is sought in the application opposed herein, is without Opposer's consent or permission.

9. Applicant's VIETTEL Mark trademark is so similar to Opposer's VIATEL mark as to be likely to falsely suggest a connection between Applicant and Opposer.

If any additional fees are required with this filing, they may be charged to deposit account number 061910.

Please address all communications to Dean R. Karau and Cynthia A. Moyer, Fredrikson & Byron, P.A., 200 South Sixth Street, Suite 4000, Minneapolis, Minnesota 55402-1425.

**WHEREFORE**, registration by Applicant of the aforesaid trademark for the aforesaid goods would be damaging to Opposer.

**THEREFORE**, Opposer respectfully requests that the application for registration be denied.

Dated: June 19, 2013



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Cynthia A. Moyer  
FREDRIKSON & BYRON, P.A.  
Suite 4000  
200 South Sixth Street  
Minneapolis, Minnesota 55402  
Tel.: (612) 492-7178/7167  
Fax: (612) 492-7077  
E-mail: ip@fredlaw.com; dkarau@fredlaw.com;  
cmoyer@fredlaw.com

**Attorneys for Opposer**

6538992

# Exhibit A

**Generated on:** This page was generated by TSDR on 2013-06-18 12:13:51 EDT

**Mark:** VIATEL

**US Serial Number:** 74328127  
**US Registration Number:** 1785855  
**Register:** Principal  
**Mark Type:** Service Mark  
**Status:** The registration has been renewed.  
**Status Date:** Mar. 02, 2004  
**Publication Date:** May 11, 1993

**Application Filing Date:** Nov. 02, 1992  
**Registration Date:** Aug. 03, 1993

## Mark Information

**Mark Literal Elements:** VIATEL  
**Standard Character Claim:** No  
**Mark Drawing Type:** 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

## Goods and Services

**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks \*...\* identify additional (new) wording in the goods/services.

**For:** intercontinental telecommunications services  
**International Class(es):** 038 - Primary Class  
**Class Status:** ACTIVE  
**Basis:** 1(a)  
**First Use:** Feb. 26, 1991  
**U.S Class(es):** 104  
**Use in Commerce:** Feb. 26, 1991

## Basis Information (Case Level)

<b>Filed Use:</b> Yes	<b>Currently Use:</b> Yes	<b>Amended Use:</b> No
<b>Filed ITU:</b> No	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

## Current Owner(s) Information

**Owner Name:** VIATEL HOLDING (BERMUDA) LIMITED  
**Owner Address:** CEDAR HOUSE, 41 CEDAR AVENUE  
HAMILTON HM12  
BERMUDA  
**Legal Entity Type:** CORPORATION  
**State or Country Where Organized:** BERMUDA

## Attorney/Correspondence Information

**Attorney Name:** THOMAS M. FURTH  
**Attorney of Record**  
**Docket Number:** TM-1492  
**Correspondent**

**Correspondent** THOMAS M FURTH  
**Name/Address:** JORDAN & HAMBURG LLP  
122 E 42ND ST  
NEW YORK, NEW YORK 10168  
UNITED STATES

Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Sep. 21, 2007	CASE FILE IN TICRS	
Mar. 02, 2004	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Mar. 02, 2004	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Nov. 18, 2003	POST REGISTRATION ACTION MAILED - SEC. 8 & 9	
Aug. 01, 2003	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Aug. 01, 2003	PAPER RECEIVED	
Nov. 15, 1999	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jul. 26, 1999	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Aug. 03, 1993	REGISTERED-PRINCIPAL REGISTER	
May 11, 1993	PUBLISHED FOR OPPOSITION	
Apr. 09, 1993	NOTICE OF PUBLICATION	
Feb. 09, 1993	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 05, 1993	EXAMINER'S AMENDMENT MAILED	
Jan. 21, 1993	ASSIGNED TO EXAMINER	60740

## Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** Aug. 03, 2003

## TM Staff and Location Information

TM Staff Information - None

File Location

**Current Location:** SCANNING ON DEMAND

**Date in Location:** Sep. 21, 2007

## Assignment Abstract Of Title Information

### Summary

**Total Assignments:** 3

**Registrant:** VIA USA, LTD.

### Assignment 1 of 3

**Conveyance:** CHANGE OF NAME

**Reel/Frame:** [1366/0226](#)

**Pages:** 13

**Date Recorded:** Jun. 21, 1995

**Supporting Documents:** No Supporting Documents Available

### Assignor

**Name:** [VIA USA LTD.](#)

**Execution Date:** Oct. 04, 1994

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** No Place Where Organized Found

### Assignee

**Name:** [VIATEL, INC.](#)

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DELAWARE

**Address:** 18TH FLOOR  
800 THIRD AVENUE  
NEW YORK, NEW YORK 10022



Correspondent	
Correspondent Name: CHADBOURNE & PARKE	
Correspondent Address: ELAINE V. KEIM, ESQ. 30 ROCKEFELLER PLAZA, 37TH FLOOR NEW YORK, NY 10112	
Domestic Representative - Not Found	
Assignment 2 of 3	
Conveyance: REORGANIZATION PER BANKRUPTCY ORDER	
Reel/Frame: <a href="#">2791/0619</a>	Pages: 43
Date Recorded: Jul. 28, 2003	
Supporting Documents: <a href="#">assignment-tm-2791-0619.pdf</a>	
Assignor	
Name: <a href="#">VIETEL, INC.</a>	Execution Date: Jun. 07, 2002
Legal Entity Type: CORPORATION	State or Country Where Organized: No Place Where Organized Found
Assignee	
Name: <a href="#">VTL, INC.</a>	State or Country Where Organized: DELAWARE
Legal Entity Type: CORPORATION	
Address: 350 BEDFORD ST., SUITE 406-A STAMFORD, CONNECTICUT 06901	
Correspondent	
Correspondent Name: JORDAN AND HAMBURG LLP	
Correspondent Address: THOMAS M. FURTH, ESQ. 122 EAST 42ND STREET, SUITE 4000 NEW YORK, NY 10168	
Domestic Representative - Not Found	
Assignment 3 of 3	
Conveyance: ASSIGNS THE ENTIRE INTEREST	
Reel/Frame: <a href="#">2794/0965</a>	Pages: 4
Date Recorded: Aug. 01, 2003	
Supporting Documents: <a href="#">assignment-tm-2794-0965.pdf</a>	
Assignor	
Name: <a href="#">VTL, INC.</a>	Execution Date: Jul. 29, 2003
Legal Entity Type: CORPORATION	State or Country Where Organized: No Place Where Organized Found
Assignee	
Name: <a href="#">VIATEL HOLDING (BERMUDA) LIMITED</a>	State or Country Where Organized: BERMUDA
Legal Entity Type: CORPORATION	
Address: CEDAR HOUSE, 41 CEDAR AVENUE HAMILTON HM12, BERMUDA	
Correspondent	
Correspondent Name: JORDAN AND HAMBURG LLP	
Correspondent Address: THOMAS M. FURTH, ESQ. CHANIN BUILDING, SUITE 4000 122 EAST 42ND STREET NEW YORK, NY 10168	
Domestic Representative - Not Found	
Proceedings	
Summary	
Number of Proceedings: 1	
Type of Proceeding: Opposition	
Proceeding Number: <a href="#">91114719</a>	Filing Date: Jun 28, 1999
Status: Terminated	Status Date: Dec 04, 2001
Interlocutory Attorney: DAVID M MERMELSTEIN	
Defendant	
Name: VTEL CORPORATION	
Correspondent Address: P. WESTON MUSSELMAN JR.	

JENKENS & GILCHRIST PC  
1445 ROSS AVENUE SUITE 3200  
DALLAS TX , 75202-2799

Associated marks			
Mark	Application Status	Serial Number	Registration Number
V VTEL	Cancelled - Section 8	<a href="#">75442689</a>	<a href="#">2649704</a>
Plaintiff(s)			

Name: VIATEL, INC.

Correspondent Address: THOMAS M FURTH  
JORDAN AND HAMBURG LLP  
122 EAST 42ND STREET  
NEW YORK NY , 10168

Associated marks			
Mark	Application Status	Serial Number	Registration Number
VIATEL	Renewed	<a href="#">74328127</a>	<a href="#">1785855</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jun 28, 1999	
2	NOTICE SENT; TRIAL DATES RESET; ANSWER DUE	Sep 02, 1999	Oct 12, 1999
3	PENDING, INSTITUTED	Sep 02, 1999	
4	ANSWER	Sep 21, 1999	
5	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	Apr 03, 2000	
6	P'S MOT TO EXT TIME W/CONS	Jun 02, 2000	
7	ORDER TO SHOW CAUSE	Dec 20, 2000	
8	D'S MOT. TO DISMISS; MOT. TO COMPEL; MOT TO RESET VTEL'S TESTOMONY PERIOD	Dec 26, 2000	
9	P'S REQ. TO BOARD TO REVOKE ORDER TO MAI N BRIEF	Jan 10, 2001	
10	P'S MOTION TO EXT TIME TO RESP'S MOTION TO DISMISS	Jan 10, 2001	
11	P'S MOTION FOR PARITAL SUSP. PROCEEDINGS	Jan 29, 2001	
12	D'S REG FOR AMENDT. OF APPLICATION	Jan 29, 2001	
13	P'S ALLOWED 30-DAYS TO FILE W/D OF OPP.	Jun 19, 2001	
14	STIPULATED DISMISSAL OF OPP.	Oct 22, 2001	
15	BD'S DECISION: DISMISSED W/ PREJUDICE	Dec 04, 2001	
16	TERMINATED	Dec 04, 2001	
17	TERMINATED	Dec 04, 2001	

**Int. Cl.: 38**

**Prior U.S. Cl.: 104**

**United States Patent and Trademark Office**

**Reg. No. 1,785,855**  
Registered Aug. 3, 1993

**SERVICE MARK  
PRINCIPAL REGISTER**

**VIATEL**

VIA USA, LTD. (COLORADO CORPORATION)  
11 BEACH STREET  
NEW YORK, NY 10013

FIRST USE 2-26-1991; IN COMMERCE  
2-26-1991.

FOR: INTERCONTINENTAL TELECOM-  
MUNICATIONS SERVICES, IN CLASS 38 (U.S.  
CL. 104).

SER. NO. 74-328,127, FILED 11-2-1992.

FRED MANDIR, EXAMINING ATTORNEY